



U.S. Patent Application No. 09/393,576

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF FOR THE APPELLANTS

Ex parte ENOMOTO et al.

INTERNET INFORMATION DISPLAYING APPARATUS AND INTERNET
INFORMATION DISPLAYING METHOD

Serial Number: 09/393,576
Filed: September 10, 1999
Appeal No.:
Group Art Unit: 2814
Examiner: K. DINH

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Respectfully submitted,


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THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Confirmation No.: 2928
ENOMOTO et al. Group Art Unit: 2155
Serial No.: 09/393,576 Examiner: K. Dinh
Filed: September 10, 1999 Attorney Docket No. 101216-09002
For: INTERNET INFORMATION DISPLAYING APPARATUS AND INTERNET
INFORMATION DISPLAYING METHOD

REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1)

Date: October 11, 2006

I. INTRODUCTION

The Appellants have received an Examiner's Answer dated August 11, 2006, in the above-referenced appeal. Pursuant to 37 C.F.R. §41.41(a)(1) and MPEP §1208, Appellants respectfully submit this Reply Brief.

II. SUMMARY

This paper is submitted as part of an appeal from the rejections of claims 23-31 set forth in the Office Action dated July 27, 2005, in the above-referenced application. The issues on appeal are whether:

(A) claims 23-27, 30 and 31 are unpatentable under 35 USC § 103(a) over U.S. Patent No. 5,898,819 to Austin et al. (hereinafter "Austin"), in view of U.S. Patent No. 5,491,781 to Gasperina (hereinafter, "Gasperina");

(B) claims 28 and 29 are unpatentable under 35 U.S.C. § 103(a) over Austin in view of Gasperina and further in view of U.S. Patent No. 5,675,390 to Schindler (hereinafter, "Schindler").

III. ISSUES IN REPLY BRIEF

A. Rejection of claims 23-27 and 30-31 under 35 U.S.C. § 103(a)

Claims 23-27

Independent claim 23 recites, in part:

selecting an arbitrary button in said tool bar;
and
magnifying only said selected button into a predetermined size in longitudinal and lateral directions and displaying said selected, magnified button.

Claims 24-27 depend from claim 23.

In the Examiner's Answer dated August 11, 2006, the Examiner maintains the position that Austin teaches selecting an arbitrary button in a toolbar and magnifying and displaying the selected button by the disclosure thereof at col.7, line 14 - col.8, line 41; col.9, lines 15-65; the Abstract; and in Figs. 2a and 2b. Of particular interest is the Examiner's assertion that drawing Fig. 2b of Austin teaches the claimed feature of magnifying the selected button.

Austin is directed to a system for converting a colored page to a black and white page for black and white printing. To this end, Austin discloses a presentation program module that provides GUI screen displays for allowing a user to design a color presentation and to convert the color presentation to black and white with the click of a black and white preview button 58. As explained in

the Brief on Appeal dated March 17, 2006, Fig. 2a of Austin shows a presentation display screen 50, which includes the black and white preview button 58. Fig. 2b of Austin is a partial view of the presentation display screen of Fig. 2a, and shows only the black and white preview button 58.

The black and white preview button 58 is fundamental to Austin's invention. At col. 7, lines 24-28, Austin discloses "the present invention focuses on one aspect of the presentation program module 37a, the black and white presentation feature" and therefore, places "primary focus" on the "black and white view button 58..." See, Austin, col. 7, lines 24-28. It is therefore not surprising that Austin included in his patent application (specifically, in Fig. 2b thereof) a partial view of the presentation display screen of Fig. 2a showing the black and white preview button 58 alone, without the remainder of the elements of the display screen.

Austin does not disclose or suggest that selecting the button 58 results in magnification and display of the button 58. Rather, Austin explicitly discloses that "clicking the black and white preview button 58" of Figs. 2a and 2b causes a color presentation to "be converted to a standard black and white version of the presentation 62." See *id.*, col. 7, lines 47-51. Close examination of the remainder of the Austin reference reveals that Austin teaches no other outcome resulting from clicking the preview button 58. Thus, Austin clearly does not teach or suggest that clicking the preview button 58 results in the magnification and display of the preview button 58.

Despite the obvious fact that Austin does not teach or suggest that selection of the black and white preview button 58 results in the magnification and display thereof, the Examiner continues to maintain the position that the inclusion of a drawing showing a partial view of the presentation display screen of Fig. 2a in Austin's patent application constitutes a teaching by Austin of "selecting an arbitrary button in said tool bar; and magnifying only said selected button and displaying said selected, magnified button," as recited in independent claim 23.

The Appellants again submit that the Examiner's interpretation of Fig. 2b of Austin is grossly misrepresentative of the actual teachings of the reference.

Gasperina is not cited for, nor does Gasperina cure the deficiencies of Austin described above. In the Examiner's Answer dated August 11, 2006, the Examiner admits that Austin does not explicitly disclose magnifying said button into a predetermined size in longitudinal and lateral directions, and maintains the position that Gasperina teaches this feature. The Appellants respectfully disagree.

As explained in the Brief on Appeal dated March 17, 2006, Gasperina is directed to a method for displaying a portion of a computer file, such as a graphic image, in a window equipped with scroll bars. A selected portion of the file is displayed in the scroll box equipped window, and the portion or amount of the file selected to be displayed in the scroll box equipped window is variable by respectively clicking or dragging a portion of a scroll box. See, e.g., Gasperina, col. 1, line 64 - col. 2, line 1. Gasperina discloses at col. 4, lines 23-26, for

example, that when a window is "resized" by dragging a side scroll bar thereof, the image displayed within the window is scaled to provide the effect of zooming in on a portion of the image. For example, Fig. 1A of Gasperina illustrates a window "sized" to show an entire waveform depicting 24 hours worth of heart rate data, and Fig. 1B of Gasperina illustrates the window "resized" to zoom in on a portion of the waveform depicting only 3 hours worth of the heart rate data. As described by Gasperina at cols. 3 and 4, dragging a scroll box handle 28 or 30 of the window shown in Figs. 1A and 1B changes a scale of the waveform displayed in the window, so that more or less of the waveform is displayed, but does not change the size of the window or the handle.

Gasperina neither discloses nor suggests "magnifying only said selected button into a predetermined size in longitudinal and lateral directions," as asserted by the Examiner.

Moreover, applying the actual teaching of Gasperina to the button of Austin would result in the black and white preview button of Austin being displayed in a window equipped with scroll boxes, thus allowing a portion of the button displayed within the window to be varied. This is not the same as magnifying only said selected button into a predetermined size in longitudinal and lateral directions, as recited in claim 23.

Consequently, the combination of Austin and Gasperina does not disclose or suggest at least the combination of selecting an arbitrary button in said tool bar; and magnifying only said selected button into a predetermined size in

longitudinal and lateral directions and displaying said selected, magnified button, as recited in independent claim 23.

For at least this reason, the Appellants respectfully submit that claim 23, and claims 24-27, which depend from claim 23, are not obvious in view of the alleged combination of Austin and Gasperina.

Furthermore, the Appellant submits that the Examiner failed to provide sufficient motivation for combining the references in the rejection of claims 23-27 under 35 U.S.C. § 103. In the Examiner's Answer dated August 11, 2006, the Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Gasperina's teachings into the computer system of Austin because "it would have enabled users to vary a portion of [a] file displayed in a window on a monitor controlled by a computer and to select the scale of the displayed portion thus capable [of] correcting reproduced image density automatically in accordance with a density of document ground." See, Examiner's Answer, page 4.

However, Austin is cited as allegedly disclosing selecting the black and white preview button and magnifying and displaying the black and white preview button. Although, as explained above, Austin does not, in fact, teach such a feature, the Appellants respectfully submit that even if Austin did, it makes no sense to apply the teaching of Gasperina to the button of Austin to allegedly enable a user "to vary a portion of [a] file displayed in a window on a monitor..." as asserted by the Examiner. Varying a portion of a file displayed in a window has nothing to do with magnifying a button. Hence, the Appellants submit that it

would not have been obvious to make the modification to Austin using the teachings of Gasperina as proposed by the Examiner. Rather, the Appellants submit that the Examiner's stated reasons for combining the references is based on improper hindsight reconstruction using Appellants disclosure as a template.

For all of these reasons, the Appellant submits that the rejection of claims 23-27 as being unpatentable over Austin in view of Gasperina is improper, and withdrawal of the rejection is respectfully requested.

Claims 30 and 31

Independent claim 30 recites, in part:

selecting an arbitrary button in said tool bar;
and

magnifying, in longitudinal and lateral directions, and displaying the selected button upon a single user action.

Claim 31 depends from claim 30.

In the Examiner's Answer dated August 11, 2006, the Examiner maintains that Austin teaches "selecting an arbitrary button (button 58 of fig. 2a) in said toolbar (54a54i fig. 2a) and displaying said selected button in a single user action (clicking the preview button, see abstract, figs.2a, 2b, col.7 lines 14 to col.8 line 41 and col.9 lines 15-65) [sic]." Examiner's Answer, page 5, lines 14-16. The Examiner admits "Austin does not specifically disclose magnifying said button into a predetermined size in longitudinal and lateral directions," and maintains that Gasperina teaches this feature. *Id.*, lines 17-18. The Appellants respectfully disagree.

As explained above and in the Brief on Appeal dated March 17, 2006, Austin does not disclose or suggest that selecting the button 58 of Fig. 2a results in any event other than causing a color presentation to be displayed in black and white. Austin does not disclose that clicking on the button 58 of Fig. 2a does anything to the button itself upon a single user action or otherwise.

As previously explained, Gasperina does not disclose magnifying a selected button into a predetermined size in longitudinal and lateral directions. Rather, Gasperina discloses clicking and dragging a scroll bar handle of a window to change a portion of an image displayed within the window. Clicking and dragging a scroll bar handle of the window does not change a size of the window or the handle. Thus, combining the scroll bar equipped window of Gasperina, which is "operable to vary the portion of the file displayed in the window" (Gasperina col. 1, line 67 – col. 2, line 1) with the button of Austin does not yield the invention recited in claims 30 and 31. Thus, the Appellants respectfully submit that claims 30 and 31 are not obvious in view of the alleged combination of Austin and Gasperino. For at least this reason, the Appellants submit that claims 30 and 31 should be deemed allowable over the combination of Austin and Gasperina.

B Rejection of claims 28 and 29 under 35 U.S.C. § 103

In the Examiner's Answer dated August 11, 2006, the Examiner continued to take the position that claims 28 and 29 are obvious in the light of the combination of Austin and Gasperina, as applied to claim 23 above, and further in view of Schindler. The Appellants respectfully reiterate that the combination of

Austin and Gasperina does not teach the features of "magnifying only said selected button into a predetermined size in longitudinal and lateral directions and displaying said selected, magnified button," as recited in claim 23, from which claim 28 depends, and claim 29.

As stated in the Brief on Appeal dated March 17, 2006, Schindler does not overcome the above-described deficiencies in the teachings of Austin and Gasperina. Thus, adding the teachings of Schindler to the combination of Austin and Gasperina does not yield the invention as claimed in claims 28 and 29. For at least this reason, the Appellants respectfully submit that claims 28 and 29 of the above-identified application on appeal are not obvious in light of the alleged combination of Austin/Gasperina and Schindler. Thus, claims 28 and 29 should be deemed allowable over the combination of Austin, Gasperina and Schindler.

IV. Conclusion

In summary, therefore, and for all of the above-noted reasons, it is strongly contended that clear differences exist between the present invention as recited in claims 23-31 and the prior art relied upon by the Office Action. It is further contended that these differences are such that the present invention would not have been obvious to a person having ordinary skill in the art at the time the invention was made.

In view of the above, it is respectfully requested that this Reply Brief be entered into this appeal, and this Honorable Board of Patent Appeals and Interferences reverse the Examiner's decision in this case and indicate the allowability of claims 23-31.

In the event that this paper is not being timely filed, the Appellants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees which may be due with respect to this paper, may be charged to Counsel's Deposit Account No. 01-2300, **referencing docket number 101216-09002.**

Respectfully submitted,


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